

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

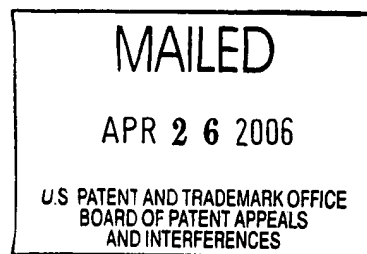
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. SAVAGE and PAUL A. JOYCE

Appeal No. 2006-1322
Application No. 09/736,032

ON BRIEF



Before HAIRSTON, KRASS, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19.

The invention is directed to a system for electronically writing prescriptions and implementing advertising on hand-held electronic devices.

Representative independent claim 1 is reproduced as follows:

1. A hand-held electronic device comprising:
a central processing unit,

random accessible memory;

a viewing screen;

a motherboard;

a modem;

data entry means;

prescription writing means;

at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device; the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo, and,

updating means for updating the at least one advertisement.

The examiner relies on the following references:

Reilly et al. (Reilly)	5,740,549	Apr. 14, 1998
Lupi	5,755,462	May. 26, 1998
Goetz et al. (Goetz)	6,421,650	Jul. 16, 2002
		(filed Mar. 02, 1999)
Kolls	6,601,037	Jul. 29, 2003
		(filed Jun. 17, 1999)

Claims 1, 2, 4, 5, 8, 11, 15, and 19 stand rejected under 35 U.S.C. §103 as unpatentable over Reilly, Goetz, and Kolls.¹

Claims 7, 12, 16, and 18 stand rejected under 35 U.S.C. §103 as unpatentable over Reilly, Goetz, Kolls and Lupi.

¹While claim 6 has not been included in the statement of the rejection by the examiner, it was apparently intended to be grouped with these claims and we will so treat it. Note page 7, lines 15-16 of the answer.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that, in accordance with the grouping at page 6 of the brief, all claims will stand or fall together. Accordingly, we will focus on independent claim 1.

As to this claim, the examiner identifies column 6, lines 25-30, column 1, lines 12-21, column 11, lines 43-45, and column 8, lines 55-67, of Reilly as disclosing an electronic device comprising a CPU, a RAM, a viewing screen, a motherboard, a modem, and a data entry means.

The examiner points to column 3, lines 5-15, of Reilly for a showing of at least one advertisement being viewable on the viewing screen and being permanently stored in the device.

The examiner identifies Figure 6, column 9, line 65 through column 10, line 10, column 2, lines 4-25, and column 13, lines 18-21, of Reilly for an advertisement being chosen from a group consisting of color highlighting of associated product, color background graphics identifying the product, video, animation, color, splash screen displayed in between a prescribing session, and company logo.

Column 3, lines 5-15, of Reilly is identified by the examiner as disclosing an updating of the advertising via updating the software.

It is the examiner's view that what is lacking from Reilly is an explicit disclosure of the device being hand-held, that information is printed, and that the device is a prescription writing means.

The examiner turns to Goetz for a disclosure of a hand-held device (column 5, lines 35-41, Figure 1); that transmitted information may be prescription information (Figure 9, column 10, lines 17-23), and that the prescription information may be printed (column 6, lines 8-15).

The examiner also turns to Kolls for a disclosure of audio, video, audio-visual (column 14, lines 50-55, and column 33, lines 60-63) and coupon printing (column 17, lines 50-55).

The examiner concludes from all this that it would have been obvious to add Goetz's prescription information and utilization of a PDA, and Kolls' advertisement features, to Reilly's remote computer with locally stored advertising that gets updated. The examiner's rationale is that "a PDA is a standard type of computer, prescription information is standard type of information stored in a computer, and printing information is a standard feature of computers with interfaces so that the user

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can receive a hard copy of the information viewed" (answer-pages 4-5).

Appellants argue that there is no motivation to combine the references since Goetz makes no reference to advertising in any form and neither Reilly nor Kolls discusses a prescription writing device having at least one advertisement permanently stored in the software. Moreover, appellants argue, it would not have been desirable to combine the manner in which Reilly and Kolls disclose advertising with the hand held device of Goetz because the "amount of data being downloaded as suggested by Reilly and Kolls would quickly overflow the data storage capability of the hardware of Goetz as it is vastly smaller than the data storage capabilities of the hardware for Reilly and Kolls" (brief-page 8).

We are not persuaded by these arguments of appellants as they appear directed to the references individually rather than being directed to the combination as a whole. It may be true that the different references provide for different parts of the claimed subject matter, as Goetz describing a hand-held prescription writing device and Reilly and Kolls describing advertising, but this, per se, is an insufficient reason for concluding that the references cannot be combined. If one

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reference taught all of the claimed subject matter, the rejection would have been under 35 U.S.C. §102, rather than §103.

Moreover, the artisan would have been well aware of the storage capabilities argued by appellants and appropriate accommodations would have been made to ensure that sufficient storage capability was provided in Goetz before modifying the teachings of the reference to permit downloading of data. A proper combination under 35 U.S.C. §103 does not require bodily incorporation of the teaching of one reference into another, paying no attention to what the artisan of ordinary skill would consider in making the combination. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). We would also note, as did the examiner, at page 10 of the answer, that the claims make no mention of any "data storage capability," and so appellants' argument regarding storage capability, although understood to be argued as a reason not to combine the references, rather than as a specific claim limitation, is not persuasive.

Appellants also argue that none of the applied references teach or suggest "permanent storage" of the advertisements as part of the software code of a prescription writing device. In contrast, appellants contend that Reilly and Kolls discuss frequent downloads of advertising files based on a given user profile read by a module of the personal computer software.

"That is to say, the advertising displayed on the screen of the computing devices of either Reilly or Kolls is not permanently contained within the software code. A person of ordinary skill in the art would recognize these files as being temporarily stored in the memory of the computing device" (brief-page 8).

We disagree with appellants. As pointed out by the examiner, Reilly discloses, at column 3, lines 5-15, that advertisements are stored in local memory, where they are updated from time to time by information from a server. Accordingly, it does appear that the advertisements in Reilly are in "permanent storage," as claimed. As far as appellants' argument about the advertisement being permanently contained in the software code, the claims stand or fall together by appellants own choosing and chosen independent claim 1 makes no mention of any advertisement being permanently contained in a software code. Rather, the claim requires "at least one advertisement being permanently stored on the device." Since the "local memory" of Reilly is clearly not a volatile memory, Reilly does disclose the permanent storage claimed.

Appellants again assert, at page 9 of the brief, that in sharp contrast with the scheme of continuously downloading advertising files as in Reilly and Kolls, the advertisements of

the instant invention are permanently stored in the software code to make best use of the hardware.

Again, this argument is not persuasive as independent claim 1 does not require any such permanently stored advertisements in software code, but rather only a permanent storage in the device.

The remainder of appellants' arguments at page 9 of the brief is directed to PCs having "more powerful microprocessors;" "limited amount of data storage capabilities," and distinctions between hand held devices and PCs. None of these arguments are persuasive as appellants have pointed to no specific claim language that is being alleged as distinguishing over the applied references. Arguments must be specifically directed to the instant claim language and what appellants are alleging to distinguish over the prior art.

At pages 10-11 of the brief, appellants again argue a lack of motivation to combine the references. In particular, appellants point out that Reilly and Kolls make no mention of a prescription writing device and that any advertising taught in these references is done over a wide area communications network by downloading files on a continuously ongoing basis, whereas the advertising of the instant invention relates to a single user, a physician, who views a splash screen advertisement, permanently stored in the software of a prescription writing device.

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Appellants argue that Goetz is no help in this regard as it mentions nothing about advertising.

Again, we note that appellants' arguments appear to be directed to the references individually, rather to what the combination would have suggested. Moreover, the claims do not limit the number of people to whom the advertisement can be directed, nor do the claims limit the permanently stored advertisement to being stored in "software." Accordingly, appellants' arguments are not persuasive.

At page 12 of the brief, appellants note the "distinctiveness between downloading advertising files and updating software that permanently stores a splash screen and/or an audible signal."

As noted supra, the claims do not preclude downloading of updated advertisements (the claims do not state how the advertisement is input to the permanent storage) and the claims do not require that "software" be updated, only that the advertisement be updated.

At pages 12-14 of the brief, appellants argue that Goetz could not function in a manner which would allow the prescription device of Goetz to download volumes of data from the Internet and store the data in non-volatile memory as Goetz neither has the data storage capacity nor the high end processing power as that

of a PC. Appellants limit the artisan to only what a particular reference explicitly discloses. However, in determining what would have been obvious to an artisan, within the meaning of 35 U.S.C. §103, one must look at the teachings of the prior art, the suggestions gleaned therefrom, and what the artisan would normally know. In the instant case, Goetz clearly teaches a hand-held electronic device for use by a physician to prescribe medication (column 5, lines 35-45 of Goetz). Reilly discloses an electronic device, though not necessarily hand-held, which comprises the CPU, RAM, screen, motherboard, modem, and data entry means claimed as part of the electronic device. Reilly's electronic device provides for an advertisement permanently stored in a local memory at the electronic device, and for updating that advertisement. Kolls teaches that a system may be interactive, using audio and/or video means to communicate data.

It is clear to us that the artisan would have been led to combine these teachings to provide advertising on the device of Goetz, if desired, based on the Reilly teachings. Once this decision is made by the artisan (it is clear that Reilly does suggest providing an advertisement on a user's electronic device), it must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The conclusion

of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

In applying the teachings of Reilly, viz., providing an advertisement permanently stored in an electronic device, to Goetz's device, the artisan would have known that one does not and cannot boldly substitute one device for another but, rather, that modifications dictated by specific equipment would have been necessary. Again, the problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Thus, in downloading advertisements to the Goetz device, the artisan would have been well aware of the storage capability needed and the necessary modifications to Goetz in this area in order to effect such a download.

Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a

rejection. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). It can be presumed that the artisan seeking to modify Goetz in order to download advertisements, in the manner of Reilly, would have known to adjust the memory size of the Goetz device in order to provide for large amounts of data. This was well within the skill of the artisan at the time of applicants' invention.

At pages 14-16 of the brief, appellants argue that all of the instant claim limitations are not met by the applied references, particularly pointing out the claim language of "advertisement being permanently stored on the device." However, as we concluded supra, the local memory in Reilly which stores an advertisement meets this claim limitation.

At pages 16-17 of the brief, appellants argue that the references "teach away" from the subject invention. In particular, appellants again point out that the advertisements in Reilly and Kolls are not updated by updating software code. The argument is not persuasive, again, because the instant claims do not require that a "software code" be updated.

Appellants argue (page 17 of the brief) that Reilly actually teaches away from the instant invention because it teaches away

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from the feature of permanently storing advertisements into the operating code of a prescription writing device. Once again, as we have explained supra, nothing in the instant claims requires storing advertisements in "the operating code" of a prescription writing device.

We have considered all of appellants' arguments and find none of them convincing of any error in the examiner's reasonable rationale for rejecting the instant claims.

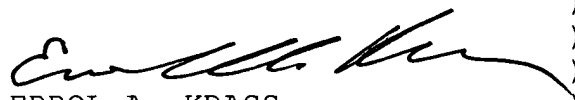
Accordingly, the examiner's decision rejecting claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19 under 35 U.S.C. §103 is affirmed.


No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

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AFFIRMED


KENNETH W. HAIRSTON)
Administrative Patent Judge)


ERROL A. KRASS)
Administrative Patent Judge)


HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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